



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,041	07/16/2007	Susumu Yoshida	IWI-16045	8816
7609 7590 11/19/2010 RANKIN, HILL, & CLARK LLP 23755 Lorain Road - Suite 200 North Olmsted, OH 44070-2224				
EXAMINER				
GREENE, IVAN A				
ART UNIT		PAPER NUMBER		
1619				
MAIL DATE		DELIVERY MODE		
11/19/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/540,041

**Applicant(s)**

YOSHIDA ET AL.

**Examiner**

IVAN GREENE

**Art Unit**

1619

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 November 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: claim 23 added, no claims canceled. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 10-19.  
Claim(s) withdrawn from consideration: 20-22.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Cherie M. Woodward/  
Primary Examiner, Art Unit 1617

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's amendment incorporating the limitations of claims 10-14 in a single new claim would require further consideration because the previously presented claims did not depend one from the other (i.e. claims 10 & 11 have been considered as a whole; claims 10 & 12 have been considered as a whole; and claims 10, 13 & 14 have been considered as a whole; claims 10-14 have not been considered as a whole). Accordingly the instantly amended claims are not being entered after final.

Applicant's arguments filed 11/03/2010 have been fully considered and are not considered sufficiently convincing to place the instantly claimed invention in condition for allowance. The examiner notes that applicant's arguments regarding anticipation are misplaced as no rejections based upon 35 U.S.C. 102 have been made (argument's p. 6, line 7; p. 8, line 13).

Applicant's argument's regarding the substitution of the thickener succinoglycan in the invention of Brieve (p. 6, last paragraph through p. 7) have been considered and are not convincing. Applicant's assertion that the thickening behavior (i.e. rheological properties) of xanthan gum and succinoglycan are quite different are unsupported by evidence or scientific reasoning. Applicant's arguments contain a table comparing the settling and thickening properties of xanthan gum and succinoglycan, however it is unclear how that data was obtained. Furthermore, the data is not presented in the form of a sworn affidavit, accordingly it is not of sufficient weight to support overcome the obviousness rejection. Regarding the exact amount of succinoglycan, Knipper teaches that a suitable amount of the polysaccharide ranges from 0.1% to approximately 5% which overlaps with the claimed range. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Furthermore, it is noted that generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (see MPEP § 2144.05-I, and II-A). Accordingly, applicant's arguments regarding the amount of succinoglycan suitable for use is the invention of Brieve are unconvincing.

Applicant's arguments regarding the use of the recited plasticizers to solve the problem of "settling" have been fully considered and are not considered convincing because glycerol, for example, is a known cosmetic ingredient and known to be useful in the claimed range. And while glycerol (and the other plasticizers) would have been expected to have a range of properties, those properties are inherent and the use of, for example, glycerol in the claimed amount would result in the claimed property (i.e. solving the problem of "settling"). A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) (MPEP §2112.02).

Applicant's submission of form IB 304 is acknowledged, and the lack of submission of the foreign priority documents from the International Bureau is being investigated. However, applicant is advised that foreign priority remains denied because Applicant is not in compliance with 119(a-d) because no English language translation of the Japanese language foreign priority documents, has been submitted.